



17 December 2003

# TECHNOLOGY LAW UPDATE

*A report of the latest Federal Circuit updates brought to you by Preston Gates.*

## Kumar v. Ovonic Battery Co.

Nos. 02-1551 et al. (Fed. Cir. Dec. 11, 2003).

***“Although it is firmly settled that an applicant may act as a lexicographer in the specification, the specification cannot support a definition that is contrary to the ordinary meaning of a claim term unless it communicates a deliberate and clear preference for this alternative definition.”***

On December 11, 2003, the Federal Circuit vacated and remanded the district court’s summary judgment that Ovonic did not infringe U.S. Patent No. 4,565,686, which related to the use of rare earth-transition metal alloys for hydrogen storage in rechargeable nickel metal hydride batteries. The Federal Circuit stated:

The central question here is one of claim construction, specifically the meaning of the term “amorphous” in claims 1 and 6 of the ’686 patent. [W]e look first to the dictionary definition of a contested term. Ovonic urges that the correct definition appears in Webster’s Third New International Dictionary, defining amorphous as “without real or apparent crystalline form: uncrystallized.” . . . Kumar, on the other hand, points out that the ’686 patent referenced the Polk patent, U.S. Patent No. 4,116,682 (issued Sept. 26, 1978) (the “Polk patent”), as prior art; that the Polk patent was extensively discussed and distinguished during prosecution . . .

[A]lthough the dictionary can be an important tool in claim construction by providing a starting point for determining the ordinary meaning of a term to a person of skill in the art, “the intrinsic record” can resolve ambiguity in claim language or, where clear, trump an inconsistent dictionary definition. Our cases also establish that prior art cited in a patent or cited in the prosecution history of the patent constitutes intrinsic evidence. [T]he Polk patent is not simply cited in the ’686 patent as pertinent prior art; nor is there any showing that the Polk patent adopted a special definition at variance with that prevailing in the art. Rather the Polk patent was considered by both the applicant and the examiner to be highly pertinent prior art, and there is no indication that the Polk patent’s express definition (even if inconsistent with the general dictionary definition) was in any way at variance with the definition that would have been used by those skilled in the art at the time. Indeed, as noted below, Ovonic’s own ’440 patent, though issued some few years after the issuance of the Kumar patent, uses the same definition, thus at least suggesting that the “long range order” definition was not unique to the Polk patent. [W]e conclude that the Polk patent definition is to be preferred over the general dictionary definition relied upon by Ovonic. This Polk patent definition should control unless the specification clearly states an alternative meaning or this meaning was disclaimed during prosecution. Here, the specification and prosecution history do not require a different interpretation than the Polk patent’s definition. [T]he specification cannot support a definition that is contrary to the ordinary meaning of a claim term unless it communicates a deliberate and clear preference for this alternative definition. . . .

Kumar surrendered a broad claim covering all partially crystalline material, but did not thereby surrender the subset of such material within the scope of the definition of “amorphous.” At most the prosecution history is confusing in this respect, and the surrender is not clear and convincing as required by our cases. [T]here is nothing in the prosecution history that defines the term “amorphous.” We have held that “[i]t is inappropriate to limit a broad definition of a claim term based on prosecution history that is itself ambiguous,” as it is in this case. Accordingly, neither the prosecution history nor the specification supports a definition of amorphous contrary to the plain meaning as defined by the Polk patent.